

REMARKS/ARGUMENTS

The application has been carefully reviewed in light of the December 14, 2006 Office Action. In response, applicant has amended claims 1 and 21 and added new claims 26 and 27. Reexamination and reconsideration of the application, as amended, is respectfully requested.

CLAIM REJECTIONS

Claims 1, 3-5, 7-13 and 21-25 were rejected under 35 U.S.C. §112, as failing to comply with the written description requirement. More particularly, the Examiner indicated that the newly added limitations of "at least one rubber sheet" in independent claims 1 and 21 did not have support in the original disclosure as the original disclosure supported two rubber sheets and one fabric sheet. In response, applicant has amended independent claims 1 and 21 to recite placing at least one mesh fabric sheet of synthetic fibers between first and second layers of rubber material, which is supported by the Specification.

Claims 1, 5 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082).

Independent claim 1 recites a method for manufacturing an animal chew toy, comprising the steps of providing first and second layers of rubber material formed in a general shape and size of the animal chew toy. A floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy is placed between the first and second layers of rubber material. The sheets of rubber and floss material are molded into the chew toy by compressing the sheets of rubber and floss material between opposing mold members under pressure and heat. Independent claim 14 recites similar steps, but specifies that the first and second layers are of a tire rubber material.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

MAMMO-44436
SN: 10/701,052
RESPONSE5
2/12/07

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing *In re Vaeck*, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

The Cooper reference is directed to a flexible waterproof flying disc. A single piece of flexible, non-porous, water impervious material comprising synthetic rubber, and more particularly closed-cell neoprene, defines the generally circular section or generally disc-shaped core 18 of the Cooper flying disc. A first fabric layer is bonded to the upper surface of the core 18, and a second fabric layer is bonded to the lower surface of the core, such that the core is covered by the fabric layers 20 and 22, which conform to the shape of the core (column 3, lines 57-63). During use of the flying disc 10 in wet environments, the thin fabric layers protect the core 18 and retain some moisture to give the flying disc sufficient weight to provide the flying disc with realistic dynamic characteristics, such as stability, improved flight performance and improved handling. Additionally, the properties of the nylon fabric layers enable the retained moisture to be sprayed during flight of the flying disc, providing an aesthetic display during flight as well as further improving its flight performance (column 4, lines 27-40).

Applicant respectfully asserts that the Cooper reference does not disclose the steps of providing a layer of synthetic fibers, and creating a multi-layer rubber and synthetic fiber sheet by attaching a first sheet of rubber material to a surface of the synthetic fiber layer, and attaching a second sheet of rubber material to an opposite surface of the synthetic fiber layer, as recited in independent claims 1 and 14. Instead, as described above, Cooper discloses providing a closed-cell neoprene center core or body, covered by two sheets of nylon fabric. Cooper creates this arrangement intentionally for various purposes, including those discussed above.

However, in the present invention, the synthetic fibers are embedded within the rubber material, and for completely different purposes, including providing strength to the rubber material and providing a floss characteristic when the animal chews the chew toy.

In the Office Action, the Examiner admitted that Cooper does not teach a compression molding process for bonding the rubber and fabric sheets. Accordingly, Cooper was combined with Ou, which teaches a compression molding process for creating an American football supported with a construction liner. Ou discusses, in column 3, lines 51-53, that in a preferred embodiment two fabric linings 242 are attached to both sides of a single rubber piece 241. In column 4, lines 3-6, Ou states that more than one rubber piece 241 and/or more than two pieces of fabric linings can be united to form a thicker and/or stiffer construction liner. The rubber and fabric sheets are cut into elliptical rubber pieces, which are compressed and vulcanized to create the rubber-based fabric liner. Four such construction liners are placed on inner surfaces of cover skins 23 to form four cover pieces, which are sewn together at the edge to form the ball cover. An inflatable rubber bladder is then inserted into the ball cover, and the inlet opening is sewn to form the American football.

The teachings of Cooper and Ou are only analogous to one another given the teachings of the present application; otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. v. Clonetech Laboratories, Inc.*, 56 USPQ 2d 1186 (Fed. Cir. 2000).

The only teachings of Ou that appear at all related to the animal chew toy of the present application is the fact that Ou compression molds fabric sheets onto rubber sheets. However, other than this similarity, the present invention and the Ou invention are completely non-analogous and unrelated to one another. The Cooper and Ou references are even less analogous and related to one another, as it would

be completely undesirable to compression mold the outer fabric layers of Cooper onto the closed-cell neoprene core. In fact, subjecting the Cooper disc to such a methodology could destroy it and prevent the utility described in Cooper of having fabric layers on opposing outer surfaces of the closed-cell neoprene core.

Obviousness cannot be established by combining the teachings of prior art references to produce the claimed invention absent some teaching or suggestion supporting the combination. The teachings from different references can be combined to invalidate a patent only if there is some teaching or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 932-933 (Fed. Cir. 1984). It is improper to use the patent in suit as a guide through a maze of prior art references, combining the right references in the right way so as to achieve the results of the claims sought to be invalidated. *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199-200 (Fed. Cir. 1983).

Thus, the Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing *In re Mills*, 16 USPQ 2d 1430 (Fed. Cir. 1990). Applicant respectfully asserts that there is no suggestion or motivation in either the Cooper reference or the Ou reference themselves to modify the references or to combine the reference teachings as proposed by the Examiner. As described above, Cooper discloses a closed-cell neoprene, flexible disc having its outer surfaces covered by bonded fabric layers. In its preferred form, the Ou reference also provides fabric layers on opposing surfaces of a rubber piece, which has been compression molded to the other. In any event, there would be no motivation to compression mold the fabric sheets onto the central neoprene core of

Cooper, and in fact such could destroy the intended utility and benefits of the arrangement that Cooper has listed in its patent.

Moreover, neither Cooper nor Ou disclose placing at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of an animal chew toy between first and second layers of rubber material formed in a general shape and size of the animal chew toy, and compression molding the layers into the final shape and configuration of the animal chew toy. Thus, from the foregoing, applicant respectfully asserts that the rejection is improper and should be withdrawn.

Claims 3-4, 15-16 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper in view of Ou and further in view of Willinger (U.S. Patent No. 6,622,659). These claims are directed to the recitation that the rubber material comprises a tire rubber material. More particularly, claims 4 and 15 recite that the tire rubber material comprises natural or synthetic rubber mixed with carbon black. Willinger (U.S. Patent No. 6,622,659) was combined with the aforementioned patents as neither of these patents teach a tire rubber material mixed with carbon black. Willinger discloses the creation of spherical and spherical polyhedral skeletal animal toys constructed of various rubber materials. In column 6, Willinger discloses the use of a rubber reinforced with carbon black. However, there is no motivation to combine Willinger with any of the foregoing references. The fact that rubber reinforced with carbon black so as to have hot and cold tear resistance and resilience qualities is of no consequence to these references, nor to the present invention. In fact, such qualities could negatively impact the flexible properties of the Cooper waterproof flying disc.

Claims 12 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper, in view of Ou, and further in view of Edwards (U.S. Patent No. 4,513,014). As described in the Specification, natural rubber mixed with carbon black creates a tire rubber material, which has an unpleasant odor. In order to mask this unpleasant odor, a scent, such as peppermint or the like, is added to the rubber material during the manufacturing process. In Edwards, the chewable

toy for the animal is shaped to simulate a dog bone and a surface-migrating flavoring pleasing to the animal is mixed with the material comprising the toy during manufacturing. Thus, this is a flavoring for the animal, as opposed to a scent so as to mask an undesirable scent of the material comprising the animal chew toy.

Claims 7, 9-11, 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper, in view of Ou, and further in view of Markham et al. (U.S. Patent No. 5,904,118). Moreover, claims 8 and 18 were rejected under this same combination of references.

Applicant respectfully asserts that Markham does not provide the deficiencies in the combination of Cooper and Ou, as described above. Thus, Markham is applied only to dependent claims of independent claims which are otherwise patentably distinct from the cited references.

Moreover, there is absolutely no motivation to combine the teachings of Markham, et al. with Cooper and Ou. More particularly, there would be no motivation to attach a rope to the flying disc of Cooper, as this would destroy its aerodynamic abilities and utility. Moreover, the Cooper flying disc does not have a cavity in which to insert anything, let alone an animal treat. Furthermore, the Cooper core itself is comprised of closed-cell neoprene, which is waterproof and which is buoyant. There would be no object or purpose of associating a buoyant insert with the Cooper flying disc. As recited in claim 11, the buoyant insert comprises a closed-cell foam in the present invention, whereas the Cooper flying disc itself has a core comprised of closed-cell foam material.

In determining the obviousness of an invention, it is impermissible to pick and choose from any one reference only so much of it as will support a given position while excluding other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc.*, 796 F.2d at 448 [230 USPQ at 419-420] (quoting *In re 'Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

The Examiner picks and chooses aspects of the references in light of

MAMMO-44436
SN: 10/701,052
RESPONSE5
2/12/07

Applicant's claims in attempting to reconstruct Applicant's invention. The Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention

“When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...”

Uniroyal Inc. vs. Rudkin-Wiley Corp. 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the “insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher”. *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

“[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”

Ecolochem Inc. v. Southern California Edison, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffett*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

Applicant's claims are not a “shopping list” to find the individual recitations in a number of non-analogous references, or references which have no suggestion or

motivation to be combined as the Examiner has done in order to create a mosaic of pieces which would then create a facsimile of the claimed invention. This, of course, constitutes improper hindsight reasoning. This does not constitute a *prima facie* case of obviousness. Accordingly, applicant respectfully asserts that the rejections should be withdrawn as they are improper.

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper in view of Ou and further in view of Richards (U.S. Patent No. 5,020,808). Applicant will also treat the recitations of newly-added claims 26 and 27 in this discussion as well.

Richards is directed to a tossing ring utilizing a pair of annular bodies superimposed on one another such that the end surface of one of the annular bodies extends further outwardly from the openings of the other annular body(ies). Two or three annular bodies are stacked upon one another in such offset arrangement to create the tossing ring of Richards. The overlapping annular bodies are adhered to one another, such as by using glue. Richards discusses that this arrangement exhibits aerodynamically stable flight, and exhibits great aesthetic appeal.

In the Office Action, the Examiner asserts that Richards teaches a tire shaped flying disc (animal chew toy). However, applicant respectfully disagrees with this assertion. Aside from being generally circular, the Richards tossing ring arrangement has absolutely no appearance or configuration resembling that of a tire. Richards does not disclose an outer periphery having a tread design formed over at least a portion thereof. Nor does Richards disclose spaced apart sidewalls extending inwardly from the outer periphery to define generally aligned central apertures. Nor does Richards disclose or teach that the periphery and the sidewalls have a generally U-shaped cross-section. All of these features are inherent in the configuration of a tire, and are absent in the Richards reference. Thus, applicant respectfully asserts that the recitations of claims 13, 26 and 27 are not rendered obvious by the combination of Cooper, Ou and Richards.

CONCLUSION

From the foregoing amendments and remarks applicant respectfully asserts that the currently-pending claims (1, 3-5, and 7-27) are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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